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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,717	11/30/2000	Dale W. Malik	BS00-168	1249
38823	7590	02/10/2005	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ BELLSOUTH I.P. CORP 100 GALLERIA PARKWAY SUITE 1750 ATLANTA, GA 30339			VU, THONG H	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,717

Applicant(s)

MALIK, DALE W.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 1,2,4-21,23-28 are pending. Claims 3, 22 are canceled.

Response to Amendment

2. Applicant's arguments with respect to claims 1,2,4-21,23-28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 26-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by

Tafoya et al [Tafoya 6,829,607 B1].

4. As per claim 26, Tafoya discloses an e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server [Tafoya, automatically track, maintain, organize data entries, abstract], comprising:

an address extractor for extracting senders' e-mail addresses from incoming e-mail communications [Tafoya, extract data from incoming messages from certain email address or internet domains, col 7line 65-col 8 line 10];

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a memory for storing e-mail addresses extracted from senders' e-mail addresses in incoming e-mail communications [Tafoya, the data store, col 8 lines 10-19]; and

a checker for searching the memory for e-mail addresses associated with intended recipients of the that are provided in outgoing e-mail communications [Tafoya, the software searches for matches in resolution list, col 5 lines 1-12; col 9 lines 1-7; col 11 lines 42-50], wherein the checker generates a prompt upon detecting that an e-mail address in an outgoing e-mail communication is not present in the memory [Tafoya, prompt to user to suggest, col 13 lines 45-64; confirmation, col 10 lines 1-12].

5. As per claim 27, Tafoya discloses the memory is included in an e-mail address directory [Tafoya, address book, col 4 lines 50-57].

6. As per claim 28, Tafoya discloses the e-mail address directory additionally stores user-specified e-mail addresses [Tafoya, the user enters new email addresses, col 9 lines 50-65].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-25 are rejected under 35 U.S.C. 103(a) as obvious over Tafoya et al [Tafoya 6,829,607 B1] in view of Oseto [6,097,797].

8. As per claim 8, Tafoya discloses A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

receiving email communications incoming to the email communications server; [Tafoya, extract email address and contact information and database or address book, col 7lines 23-35];

extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server [Tafoya, extract email address and contact information, information preferably and database or address book, col 7 lines 23-35];

storing extracted domain names in a the domain name database [Tafoya, extract data from incoming messages from certain email address or internet domains, col 7 line 65-col 8 line 10];

receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network [Tafoya, LAN/WAN col 6 lines 35-49];

searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication routed in the outgoing e-mail communications [Tafoya, the

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software searches for matches in resolution list, col 5 lines 1-12; col 9 lines 1-7; col 11 lines 42-50]; and

generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled [Tafoya, prompt to user to suggest, col 13 lines 45-64].

Tafoya also taught the user has chosen to block incoming messages or Internet domain and whether the entries domain already exists in the address book or contact database [Tafoya, col 8 lines 1-9]. However Tafoya does not detail how the domain name has been extracted and stored in contact database. A skilled artisan would have motivation to improve the contact database and found Oseto's teaching.

In the same endeavor, Oseto discloses an email communication system wherein the domain is checked and stored in a table or database [Oseto, the domain of an email address is checked and stored, col 5 line 58-col 6 line 6; the address conversion table is generated for domain name, col 13 lines 48-65]

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the domain database as taught by Oseto into the Tafoya's apparatus in order to utilize the database on email system. Doing so would provide a quick, simple and efficient to maintain a cross reference of the sub addresses such as domain name to email address book.

9. As per claim 9, Tafoya-Oseto disclose searching for similarly spelled domain names is performed by checking each alphanumeric character comprised in the

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extracted domain name with the alpha-numeric characters comprised in the domain names in the database [Oseto, the domain of an email address is checked and stored, col 5 line 58-col 6 line 6; the address conversion table is generated for domain name, col 13 lines 48-65], and detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name [Tafoya, the maximum entries in the list, col 12 lines 51-65]

10. As per claim 10, Tafoya-Oseto disclose searching for similarly spelled domain names is performed by removing an alpha-numeric character from the extracted domain name and searching the domain name database for a domain name consisting of at least each of the remaining alphanumeric characters in the extracted domain name [Tafoya, the email address and contact information is searched and save or delete, col 2 line 57-3 line 8].

11. As per claim 11, Tafoya-Oseto disclose searching for similarly spelled domain names is performed by comparing the extracted domain name with reference domain names stored in the domain name database according to predetermined spelling grammar algorithms [Tafoya, compared the value of entries, col 12 lines 51-65].

12. As per claims 12,13 Tafoya-Oseto disclose the error prompt is an e-mail message from the e-mail server to the client computer transmitting the e-mail communication [Tafoya, prompt to user to suggest, col 13 lines 45-64].

13. As per claim 14, Tafoya-Oseto disclose determining whether extracted domain names are already stored in the domain name database, whereby only a single copy of an extracted domain name is stored in the domain name database as inherent feature of domain list [Oseto, the address conversion table is generated for domain name, col 13 lines 48-65].

14. As per claim 15, Tafoya-Oseto disclose storing tally information in the domain name database to tally the frequency in which domain names in the domain name database are extracted from incoming e-mail communications as inherent feature of domain list [Oseto, the address conversion table is generated for domain name, col 13 lines 48-65].

15. As per claim 16, Tafoya-Oseto disclose deleting domain names from the domain name database that are not frequently extracted from incoming e-mail communications according to respective tally information as inherent feature of domain list [Oseto, the address conversion table is generated for domain name, col 13 lines 48-65].

16. As per claim 17, Tafoya-Oseto disclose the tally information for each domain name in the domain name database includes the calendar date in which the domain name was most recently extracted as inherent feature of domain list [Oseto, the address conversion table is generated for domain name, col 13 lines 48-65].

17. As per claim 1, Tafoya-Oseto disclose a method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

creating a list of domain names in a memory receiving an incoming email communication; extracting a domain name from a sender's email address from the incoming email communications; storing the domain name in the a list of domain names in the a memory [Oseto, the domain of an email address is checked and stored, col 5 line 58-col 6 line 6; the address conversion table is generated for domain name, col 13 lines 48-65];

checking if a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the list of domain names in the memory [Tafoya, the software searches for matches in resolution list, col 5 lines 1-12; col 9 lines 1-7; col 11 lines 42-50]; and

generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication if the domain name is not included in the list of domain names [Tafoya, prompt to user to suggest, col 13 lines 45-64].

18. As per claim 2, Tafoya-Oseto disclose extracting a domain name from each e-mail address provided in the outgoing e-mail communication, wherein the e-mail communication is transmitted after checking each extracted domain name in the list of domain names, and confirming each e-mail address for which the extracted domain name is not included in the list of domain names [Tafoya, confirmation is sent, col 10 lines 1-11].

19. As per claim 4, Tafoya-Oseto disclose receiving a corrected e-mail address from the user in response to the prompt; and repeating the steps of checking a corrected domain name and generating a prompt if the corrected domain name is not included in the list of domain names [Tafoya, prompt to user to suggest, col 13 lines 45-64], until the user either confirms that the domain name provided in the e-mail address is correct or provides a domain name that is in the list of domain names [Tafoya, confirmation is sent, col 10 lines 1-11].

20. As per claim 5, Tafoya-Oseto disclose the outgoing e-mail communication is intercepted in an e-mail server to check the domain name in the e-mail address prior to transmission [Oseto, the domain of an email address is checked and stored, col 5 line 58-col 6 line 6; the address conversion table is generated for domain name, col 13 lines 48-65].

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21. As per claim 6, Tafoya-Oseto disclose the prompt is an e-mail message from the e-mail server to the user [Tafoya, prompt to user to suggest, col 13 lines 45-64].

22. As per claim 7, Tafoya-Oseto disclose the prompt is a network message to the user [Tafoya, prompt to user to suggest, col 13 lines 45-64].

23. As per claims 18-25 contain the similar limitations as set forth in claims 8-17.

Therefore claims 18-25 are rejected by the same rationale set forth claims 8-17.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
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